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09/903,500	07/12/2001	John K. Eckl	F-278	5429

7590 02/07/2002  
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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 02/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

W.M.

# Office Action Summary

Application No.  
09/903,500

Applicant(s)  
Eckl

Examiner  
James W. Myhre

Art Unit  
2162



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 12, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-36 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 12-36 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The preliminary amendment filed on July 12, 2001 has been entered and considered in the following action.

### ***Declaration Under 37 CFR 1.131***

2. The declaration filed on July 12, 2001 under 37 CFR 1.131 has been considered but is ineffective to overcome the Comesanas (5,802,498) and Hogan (5,699,528) references used to reject the present claims in the parent application, 08/772,293.

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Comesanas reference to either a constructive reduction to practice or an actual reduction to practice. First, the declaration is inappropriate in that it was executed and signed by a person other than the inventor; in this case, an attorney in the intellectual property department of the organization. Second, there are substantial gaps in time between the applicant's first disclosure of the concept of invention in July 1995, the authorization for the applicant to proceed with reducing the invention to practice in February 1996, the decision to file a patent application in June 1996, and the actual filing of the application in December 1996.

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***Claim Objections***

4. Claims 16, 27, 28, and 29 are objected to because of the following informalities:
- a. Claim 16: in line 2 the word "as" should be "has";
  - b. Claims 27, 28, and 29 should depend on method Claim 26, not apparatus Claim 21 as indicated.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-15, 17-23, 25-27, 29-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498).

Claims 12 and 18: Comesanas discloses an automated billing system and method comprising:

- a. A billing server to receive billing information (col 2, lines 55-66);
- b. A routing means for processing/routing the information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

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- c. A printer connected to the server (col 3, lines 4-24 and col 4, lines 50-53);
- d. An electronic information server to convert the billing information for electronic transmission and to transfer the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53).

Comesanas does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission.

Claims 13 and 19: Comesanas discloses an automated billing system and method as described in Claims 12 and 18 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database. However, Comesanas does not explicitly disclose that the customers' preferences are stored as a lookup table in the database. Official notice is taken that it is old and well known within the database art to place use a table format to save memory space when storing such data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a table to store the customer's selection of delivery means. One would have been motivated to use a lookup table in

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order to minimize the amount of memory required to store the information for a large number of customers. By placing the data in a table, each customer's file could have a one-bit identifier for the type of delivery instead of a much larger field to store the delivery instructions.

Claim 14: Comesanas discloses an automated billing system and method as described in Claim 12 above, and further discloses the billing server containing billing information about a plurality of recipients (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

Claim 15: Comesanas discloses an automated billing system and method as in Claim 12 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 17 and 20: Comesanas discloses an automated billing system and method as described in Claims 12 and 18 above and further discloses a means to transmit funds to the biller (col 3, lines 13-24).

Claims 21, 26, 30, and 32: Comesanas discloses an automated billing system, apparatus, and method comprising:

- a. Accessing billing information comprising a plurality of records (col 2, lines 55-66) corresponding to one recipient;
- b. Isolating each record from the billing information (col 2, lines 55-66);
- c. Extracting delivery preference information from the database for each record (col 3, lines 17-24 and col 4, lines 50-52);

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- d. Determining whether each record is intended for printed or electronic transmission based on delivery preference information (col 3, lines 17-24 and col 4, lines 50-52);
- e. Converting the billing information for electronic transmission and transmitting the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53);
- f. Routing the billing information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

Comesanas does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission.

Comesanas also does not disclose the feature in Claim 30 wherein the switch routes all of the record to the printer if the server fails or is taken out of service. Official Notice is taken that it is old and well known with the communications art to redirect output to another format/device when part of the network fails or is otherwise not available. In this instance, it would have been obvious to one having ordinary skill in the art at the time of invention was made to redirect the electronic bills in the Comesanas invention to the printer and to then transmit the bills through the normal postal channels. One would have been motivated to do so in order to facilitate timely

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transmission of the bills and receipt of payments, thus decreasing the financial loss to the crediting organization and to the customer (through the levying of “late charges”).

Finally, while Comesanas discloses retrieving the customer’s billing preference from a database, it is not explicitly disclosed whether this is the same database that contains the billing data or a separate database. Official Notice is taken that it is old and well known within the database arts that data may be stored in one, two, or more databases and then combined as needed. This is referred to as a multidatabase (MDBS) system and has been in use for many years. One of the main advantages of an MDBS is its ability to “access data from a variety of preexisting” (legacy) “databases located in various heterogeneous hardware and software environments.” (Korth and Silberschatz, “Database System Concepts”, 1991, page 518). It is also common for businesses to store transaction information (billing data) in one file or database and to store customer data (such as name, address, phone, billing and payment preferences, etc.) in a different file or database, and then extract the needed data when compiling bills, reports, etc. The two main reasons that this data is kept separate is: (1) to decrease the required storage space by eliminating storing duplicate information, such as the customer’s name and address, with each transaction completed during the billing period; and (2) to facilitate updating the customer’s data, such as address, by eliminating the need to search for and replace every instance of the data if duplicate data is maintained as in (1) above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain the customer data in the

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Comesanas invention in a database separate from the billing data. One would have been motivated to maintain separate databases for the reasons discussed above.

Claims 22 and 27: Comesanas discloses an automated billing system and method as described in Claims 21 and 26 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database.

Claims 23 and 34: Comesanas discloses an automated billing system and method as in Claim 21 and 30 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 25, 29, and 36: Comesanas discloses an automated billing system and method as described in Claims 21, 26, and 30 above and further discloses a means to electronically transmit funds to the biller (col 3, lines 13-24).

Claim 31: Comesanas discloses an automated billing system and method as described in Claim 30 above, and further discloses the billing server containing billing information about a plurality of recipients (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

Claim 33: Comesanas discloses an automated billing system and method as described in Claim 31 above, but does not disclose that each record is sanitized. Examiner notes that Applicant has defined "sanitized" in the specification (page 3, lines 24-27) as a filter "which performs a number of convenient functions, such as verifying and/or correcting the accuracy of a

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customer's address, etc.". Official Notice is taken that it is old and well known within the accounting and database arts to verify and correct data such as addresses, phone numbers, etc. in order to maintain the most up-to-date database as possible. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a means to verify and correct the information within the databases in Comesanas. One would have been motivated to verify and update the information to ensure that the bills are directed to the correct address, thus precluding the wasteful expenditure of time and funds.

7. Claims 16, 24, 28, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498) in view of Hogan (5,699,528).

Claim 16: Comesanas discloses an automated billing system as in Claim 12 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas' electronic billing processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to ensure the correctness of the information within the database. Non-receipt and/or nonviewing of the bill could indicate the need to update of the information.

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Claims 24, 28, and 35: Comesanas discloses an automated billing system as in Claim 21, 26, and 30 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas' electronic billing processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to ensure the correctness of the information within the database. Non-receipt and/or nonviewing of the bill could indicate the need to update of the information.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Tasket (6,115,458) discloses a system and method for transmitting transaction summaries (bills) "using virtually any communication modality" and to "automatically compile and transmit the summary data to a requested destination" (Abstract). This reference could be used in support of a 35 U.S.C. 103 rejection of Claims 12, 13, 18, 19, 21, 22, 26, 27, 30, and 32 above.

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b. Hilt et al (6,032,133) discloses a system and method for transmitting electronic bills and receiving payments for such bills. This reference could be used in support of a 35 U.S.C. 103 rejection of Claims 17, 20, 25, 29, and 36 above.

c. Meschi (5,142,566) discloses a method for transmitting billing data and invoices electronically to the user, wherein the user either prints of the bills and submits payments in the usual manner, or the user electronically submits payments through the computer system. This reference is cited to show the state of the art in electronic billing and payments at the time the invention was made.

d. Johnson et al (4,695,880) discloses a system and method for distributes information such as bills to either a cable television network or to a printer. This reference is cited to show the state of the art in routing billing data through different media at the time the invention was made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal of Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes for this Art Unit can be submitted to (703) 746-7240. Draft faxes may also be submitted directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-3900.



February 5, 2002



James W. Myhre  
Patent Examiner  
Art Unit 2162